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Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No. **97-2739**

First Inventor **Liu**

Title **High Toughness Plate Alloy...**

Express Mail Label No. **EL740322731US**

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)
(Submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.
See 37 CFR 1.27.
3. ☒ Specification [Total Pages **22**]
(preferred arrangement set forth below)
- Descriptive title of the invention
 - Cross Reference to Related Applications
 - Statement Regarding Fed sponsored R & D
 - Reference to sequence listing, a table, or a computer program listing appendix
 - Background of the Invention
 - Brief Summary of the Invention
 - Brief Description of the Drawings (if filed)
 - Detailed Description
 - Claim(s)
 - Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets **5**]
5. Oath or Declaration [Total Pages **2**]
- a. ☐ Newly executed (original or copy)
- b. ☒ Copy from a prior application (37 CFR 1.63 (d))
(for continuation/divisional with Box 18 completed)
- i. ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s)
named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☒ Application Data Sheet. See 37 CFR 1.76

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
- a. ☐ Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i. ☐ CD-ROM or CD-R (2 copies); or
- ii. ☐ paper
- c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement of Attorney (when there is an assignee) ☐ Power of Attorney
11. ☐ English Translation Document (if applicable)
12. ☒ Information Disclosure Statement (IDS)/PTO-1449 ☒ Copies of IDS Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. ☒ Other: **Communication & Terminal Disclaimer**

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☒ Continuation ☐ Divisional ☐ Continuation-in-part (CIP)

Prior application information.

Examiner **Wilkins**of prior application No: **09, 208, 963**Group Art Unit. **1742**

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

☒ Customer Number or Bar Code Label (Insert Customer Number or Bar Code Label here) or ☐ Correspondence address below

Name **08840**

PATENT TRADEMARK OFFICE

Address

City State Zip Code

Country Telephone Fax

Name (Print/Type) **Julie W. Meder** Registration No. (Attorney/Agent) **36216**

Signature **Julie W. Meder** Date **Feb. 7, 2002**

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

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FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT

(\$) 1250

Complete if Known

Application Number

Filing Date

First Named Inventor

Liu

Examiner Name

Group Art Unit

Attorney Docket No.

97-2739

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number

01-1000

Deposit
Account
Name

Alcoa Inc.

- ☒ Charge Any Additional Fee Required
Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status.
See 37 CFR 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Credit card ☐ Money
Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

Fee Fee Fee Fee Fee Description

Code (\$) Code (\$) Code (\$) Code (\$) Code (\$)

101 740 201 370 Utility filing fee

106 330 206 165 Design filing fee

107 510 207 255 Plant filing fee

108 740 208 370 Reissue filing fee

114 160 214 80 Provisional filing fee

Fee Paid

740

SUBTOTAL (1) (\$) 740

2. EXTRA CLAIM FEES

Total Claims 40 -20** = 20 X Fee from below 18 = Fee Paid 360

Independent Claims 2 - 3** = 0 X 84 = 0

Multiple Dependent 0 = 0

Large Entity Small Entity

Fee Fee Fee Fee Fee Description

Code (\$) Code (\$) Code (\$) Code (\$) Code (\$)

103 18 203 9 Claims in excess of 20

102 84 202 42 Independent claims in excess of 3

104 280 204 140 Multiple dependent claim, if not paid

109 84 209 42 ** Reissue independent claims over original patent

110 18 210 9 ** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 360

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Fee Fee Fee Fee Description

Code (\$) Code (\$) Code (\$) Code (\$) Code (\$)

105 130 205 65 Surcharge - late filing fee or oath

127 50 227 25 Surcharge - late provisional filing fee or cover sheet

139 130 139 130 Non-English specification

147 2,520 147 2,520 For filing a request for ex parte reexamination

112 920* 112 920* Requesting publication of SIR prior to Examiner action

113 1,840* 113 1,840* Requesting publication of SIR after Examiner action

115 110 215 55 Extension for reply within first month

116 400 216 200 Extension for reply within second month

117 920 217 460 Extension for reply within third month

118 1,440 218 720 Extension for reply within fourth month

128 1,960 228 980 Extension for reply within fifth month

119 320 219 160 Notice of Appeal

120 320 220 160 Filing a brief in support of an appeal

121 280 221 140 Request for oral hearing

138 1,510 138 1,510 Petition to institute a public use proceeding

140 110 240 55 Petition to revive - unavoidable

141 1,280 241 640 Petition to revive - unintentional

142 1,280 242 640 Utility issue fee (or reissue)

143 460 243 230 Design issue fee

144 620 244 310 Plant issue fee

122 130 122 130 Petitions to the Commissioner

123 50 123 50 Processing fee under 37 CFR 1.17(q)

126 180 126 180 Submission of Information Disclosure Stmt

581 40 581 40 Recording each patent assignment per property (times number of properties)

146 740 246 370 Filing a submission after final rejection (37 CFR § 1.129(a))

149 740 249 370 For each additional invention to be examined (37 CFR § 1.129(b))

179 740 279 370 Request for Continued Examination (RCE)

169 900 169 900 Request for expedited examination of a design application

Other fee (specify) Terminal Disclaimer

110

SUBTOTAL (3) (\$) 150

*Reduced by Basic Filing Fee Paid

SUBMITTED BY

Name (Print/Type)

Julie W. Meder

Registration No.

36216

(Attorney/Agent)

Complete (if applicable)

Telephone

(724) 337-5358

Signature

Julie W. Meder

Date

Feb. 7, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

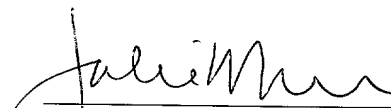
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
John Liu et al)
Serial No. (not yet received))
Filed (filed concurrently herewith)) Attorney Docket 97-2739
For High Toughness Plate Alloy)
for Aerospace Applications)

TERMINAL DISCLAIMER

I hereby certify that this correspondence is being Express
Mailed (EL740322731US) to the Assistant Commissioner
for Patents, Washington, D.C. 20231 on February 7, 2002.


Julie W. Meder, Reg. No. 36216
Date of Signature: February 7, 2002

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

Your petitioner, Alcoa Inc., having its principal office at Pittsburgh, in the County of Allegheny and State of Pennsylvania, represents that, having reviewed an Assignment recorded at Reel 9849, Frames 0963-0968, in the United States Patent and Trademark Office on March 18, 1999, it certifies that to the best of its knowledge and belief it is the assignee of the entire right, title and interest in and to the subject matter of U.S. Patent Application Serial No. 09/208,963 and any continuation thereof, including the continuation application filed concurrently herewith.

Your petitioner, Alcoa Inc., hereby disclaims the terminal part of any patent granted on the continuation application filed concurrently herewith which would extend

beyond the expiration date of any patent issuing on U.S. Patent Application Serial No. 09/208,963, and hereby agrees that any patent so granted on the continuation application filed concurrently herewith shall be enforceable only for and during such period that the legal title to any patent issuing on U.S. Patent Application Serial No. 09/208,963 shall be the same as the legal title to the patent issuing from the continuation application filed concurrently herewith, this agreement to run with any patent granted on the continuation application filed concurrently herewith and to be binding upon the grantee, its successors or assigns.

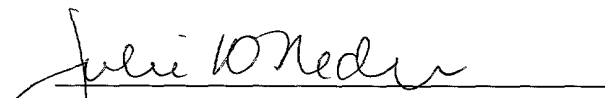
Your petitioner, Alcoa Inc., does not disclaim any terminal part of any patent granted on the continuation application filed concurrently herewith prior to expiration of the statutory term for any patent issuing on U.S. Patent Application Serial No. 09/208,963 in the event that any patent issuing on U.S. Patent Application Serial No. 09/208,963 expires for failure to pay a maintenance fee, is held unenforceable, is found invalid is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims cancelled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Respectfully submitted,



08840

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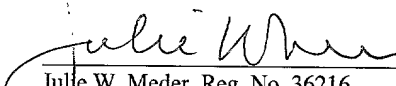

Julie W. Meder
Attorney for Applicants
Reg. No. 36216

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
John Liu et al)
Serial No. (not yet received))
Filed (filed concurrently herewith)) Attorney Docket 97-2739
For High Toughness Plate Alloy)
for Aerospace Applications)

COMMUNICATION

I hereby certify that this correspondence is being Express
Mailed (EL740322731US) to the Assistant Commissioner
for Patents, Washington, D.C. 20231 on February 7, 2002.


Julie W. Meder, Reg. No. 36216
Date of Signature: February 7, 2002

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

For the purposes of examination of the application submitted herewith,
Applicants provide the following remarks.

REMARKS

The present application is a continuation of U.S. Application No.
09/208,963 filed December 10, 1998. The specification includes reference to that parent
application. A copy of the Declaration for Patent Application submitted in the parent
application is included herewith. The text of the present application has been updated
from the parent application to correct typographical errors on pages 3-4 of the parent case
and include the same text from U.S. Patent No. 5,213,639 (which is incorporated by
reference) that was added by Amendment to the parent case, namely, the language from
the '639 patent at col. 7, line 68; col. 8, lines 1-14; col. 9, lines 17-26 and 40-68; col. 10,
lines 1-61, col. 11, lines 3-27, 47-49 and 55-68, col. 12, lines 1-27 and 38-46; and col. 13,
lines 15-24. No new matter has been introduced to the present application.

Claims 1-40 of the present application parallel allowed claims 1-40 in the parent case. However, the preambles of independent claims 1 and 2 recite an "aluminum product alloy". Based on a suggestion by the Examiners in the October 26, 2001 Interview in the parent case, the claims in the parent case were amended to recite a product type (i.e., plate) for the alloy to render it clear that the superior properties claimed are found in a final product. Likewise, the present claims are drafted to require that the alloy be in a final product form. Support therefor can be found at least in paragraphs 11, 15, and 17 and throughout the specification in reference to structural components and aerospace products such as wings.

The patentable features of claims 1-40 parallel the features of the allowed claims in the parent case, in particular, a product alloy not containing Zr which is directly counter to the prior conventional wisdom to include Zr in such products, yet which provides improvements in the physical properties of the product. Claims 1-40 of the present application define over the prior art of record in the parent case for the same reasons that claims 1-40 of the parent case are patentable. An Information Disclosure Statement listing the references cited in the parent case accompanies this Communication.

Finally, recognizing the similarity between the present claims and those of the parent case, Applicants submit herewith a Terminal Disclaimer for the present application.

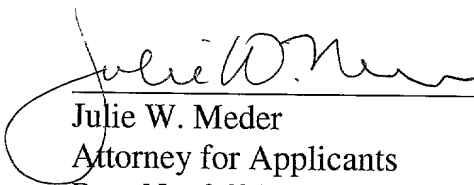
In view of the foregoing and the accompanying Information Disclosure Statement and Terminal Disclaimer, claims 1-40 are believed to be in condition for allowance. Favorable action thereon is respectfully requested.

Respectfully submitted,



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Julie W. Meder
Attorney for Applicants
Reg. No. 36216